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10/066,580	02/06/2002	Akihiko Fujii	Q68353	5449

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EXAMINER

PICKETT, JOHN G

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 07/03/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,580

Applicant(s)

FUJII ET AL.

Examiner

Gregory Pickett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Priority***

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Specification***

2. The disclosure is objected to because of the following minor informalities: Page 2, line 4, "although excellent appearance in transparency" is grammatically incorrect.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first and second paragraphs of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

"Metallocene-polyethylene" is a term used in the polymer art to refer to a polyethylene material formed through the use of a metallocene catalyst. The applicant

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has not disclosed how metallocene-polyethylene itself is used as a catalyst to form another material and one of ordinary skill in the art would not be able to make and/or use the invention claimed.

Claims 5 and 6 are dependent on claim 4 and are rejected for the above reason.

4. Claims 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

"Metallocene-polyethylene" is a term used in the polymer art to refer to a polyethylene material formed through the use of a metallocene catalyst. It is unclear whether the applicant is claiming a finished material or a specific catalyst used in forming a finished material.

Claims 5 and 6 are dependent on claim 4 and are rejected for the above reason.

To prosecute the examination, the examiner interprets the claim to mean a finished material of polyethylene formed through the use of a metallocene catalyst.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
5. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita (US 5,518,116) in view of Williams et al (US 5,720,916), Ewen et al (US 4,892,851), and Asanuma et al (EP 0 428 972 A2).

Regarding claim 1, Morita discloses a case (6) for a magnetic tape cassette (2). The case of Morita is made of a transparent resin (see for example, Col. 5, ll. 49-52). Morita does not expressly disclose the type of resin used or the components used in forming the resin.

Williams et al disclose that it is known in the art to use a resin material formed with a metallocene catalyst (see for example, Col. 1, ll. 55-63) to form articles. Williams et al teach the use of the resin material formed with a metallocene catalyst for the purpose of improved clarity of transparency and impact resistance (see for example, Col. 2, ll. 10-14). Ewen et al and Asanuma et al disclose how to make the material of Williams et al.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the case of Morita of a resin material formed with a metallocene catalyst, since it has been held to be within the general skill of a worker in

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the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 2 and 3, Ewen et al disclose that changes in the amount of catalyst used effect the overall performance of the resulting resin (see for example, Tables 1 and 2). The case of Morita-Ewen-Asanuma discloses the claimed invention except for the mass percentages claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the resin of Morita-Ewen-Asanuma using the mass percentages claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

6. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morita et al in view of Ewen et al and Asanuma et al as applied to claim 1 above, and further in view of Hanoka (US 6,114,046).

The case of Morita-Ewen-Asanuma discloses the claimed invention except for the use of a polyethylene material formed through the use of a metallocene catalyst.

Hanoka discloses a polyethylene material formed through the use of a metallocene used in an article (see for example, the Abstract). Hanoka teaches that the metallocene polyethylene is exceptionally clear with excellent physical properties (see for example, Col. 3, 7-11).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the case of Morita-Ewen-Asanuma with a polyethylene material formed with a metallocene catalyst, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

As to claims 5 and 6, the case of Morita-Ewen-Asanuma-Hanoka discloses the claimed invention except for the mass percentages claimed by the applicant. It would have been obvious to one of ordinary skill in the art at the time the invention was made to form the resin of Morita-Ewen-Asanuma using the mass percentages claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

### ***Conclusion***


7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yamamoto et al disclose an ethylene resin formed using a metallocene catalyst.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 703-305-8321. The examiner can normally be reached on Mon-Fri, 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

  
Gregory Pickett  
Examiner  
June 27, 2003

  
Mickey Yu  
Supervisory Patent Examiner  
Group 3700